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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,186	12/01/2003	Gregory J. Boss	YOR920030466US1	3429
59144 7590 03/31/2011 CAHN & SAMUELS, LLP 1100 17th STREET, NW SUITE 401 WASHINGTON, DC 20036				
EXAMINER				
DURAN, ARTHUR D				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/726,186

Applicant(s)

BOSS ET AL.

Examiner

Arthur Duran

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1.5-21.25-31 and 35-48, 49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1.5-21.25-31 and 35-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Correspondence Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claims 1, 5-21, 25-31, 35-49 have been examined.

Response to Amendment

The Amendment filed on 6/18/10 is sufficient to overcome the prior rejection.

However, a new 103 rejection has been made.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/18/10 has been entered.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 21 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. This is a program product claim. However, the preamble of the claim does not disclose any computer readable storage medium or computer readable non-transitory medium. Rather the body of the claims is interpreted as purely software. Software is *per se* not a statutory class of invention. Therefore the claim is rejected under 35 U.S.C. 101 because it is directed to software which is not a statutory class of invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 5-21, 25-31, 35-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cowden (2003/0098882) in view of Loughmiller (2005/0076084) in view of Jeannin (20020083469) in view of Messer (20040230491).

Claim 1, 21, 31: Cowden discloses a method of managing a display of an unsolicited instant advertisement, comprising:

detecting an attempt to display the unsolicited instant advertisement in a primary browser window; and

relocating the unsolicited instant advertisement to an alternate location that is not part of the primary browser window, without deleting the unsolicited instant advertisement ([81]; Figures 7, 8).

Also, Cowden discloses the method of claim 1, wherein the alternate location comprises any one of a file or a database or container ([81]) or a secondary browser window ([81, 11]).

Additionally, on 5/18/10, Applicant added the following new claim amendments to the independent claims:

"characterizing unsolicited instant advertisements in the database from metadata attached to content of the unsolicited instant advertisements; and sorting the unsolicited instant advertisements in the database."

However, Cowden discloses a filtering criterion (Figure 7) and saving bad pop-ups for later viewing ([81] and rejection above). Cowden further discloses presenting ads of interest to the user (Figure 7; [10, 11]). Cowden does not explicitly disclose saving the unsolicited advertisement that meets the filtering criterion. However, Loughmiller discloses filtering, classifying, organizing, and storing both good and bad messages/pop-ups (Abstract, Figure 5) and that Loughmiller's system can work with a variety of content/messages including pop-ups ([14, 126, 129]). Loughmiller further discloses a database for storing ads ([34]). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Loughmiller's filtering content and storing both good and bad content can be added to Cowden's filtering content and storing bad content. One would have been motivated to do this in order to allow Cowden's users to view ads of interest at their discretion. Cowden does not explicitly disclose using metadata to characterize the ads or that the ads can be sorted. However, Jeannin discloses filtering ads based on metadata ([16, 44]) and that ads can be sorted or organized or searched based on metadata (claims 8, 16; [15, 44, 38]). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Jeannin's metadata with ads to Cowden's filtering ads. One would have been motivated to do this in order to better filter ads.

Additionally, on 6/18/10, Applicant added the following new claim amendments to the independent claims:

“scanning the content of the unsolicited instant advertisement for hyperlinks; and automatically activating at least one of the hyperlinks to reward a web site issuing the unsolicited instant advertisement.”

Applicant Spec at these paragraphs was found relevant to these features (from PG_Pub [8, 19, 45, 46]). Also, Applicant states that it is obvious old and well known that (from Applicant's Background of Invention):

“[0008] The web site host tracks the response to unsolicited instant ads on particular web sites. When a user clicks on an unsolicited instant ad, a unique set of information is sent to the web host's server indicating that an advertisement posted through a specific web site garnered a response. The web site responsible for that ad then receives a credit, for example. These credits may translate to money or to other benefits. Conversely, if no visitors to a web site respond to the advertisements or the unsolicited instant ads are “killed” (i.e., closed) by instant ad managers, no revenue is generated by the web site for the web site host. The web site host may then choose to close the web site because it generates no revenue for the web site host.”

Hence, it is obvious, old and well known that sites receive revenue from ads being clicked on.

Cowden further states that websites or web server operators receive revenue from ad activations, “[0005] A typical commercially-operated web server on the Internet includes some form of advertising. The advertising may be for goods or services. The

advertising may also be non-product related (e.g., "vote for John Doe"). Regardless of their message, these advertisements provide revenue to the web server operator."

Jeannin further discloses advertisers collect revenue from advertisements ([41]).

Cowden further discloses the use of Scripts for automatic web page code activation ([82]). Hence, it is obvious that Cowden can automatically click on the links for ads or the links for unsolicited ads in order to generate revenue for a website or web server operator. As a further example of this, Messer 20040230491 discloses tracking revenue from ads ([29, 47]). And Messer discloses automatically clicking on ads to increase revenue for a website or web server operator ("[6]... exemplary fraud of concern includes use of a process that employs a Javascript to artificially multiply the number of clicks, impressions and/or sales on a banner or similar promotional piece. . . [37]... A positive detection branches logic to the next Test, 240 for detecting the existence of the Javascript in association with the promotion vehicle, e.g. a banner ad..."; also [6, 14, 37, 38]). Hence, it is obvious that Cowden can automatically click on the links for ads or the links for unsolicited ads in order to generate revenue for a website or web server operator. One would be motivated to do this to better generate ad revenue. Alternatively, it would have been obvious to one having ordinary skill in the art at the time of the invention to combine the features of the two inventions since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Alternatively, as the prior art combination shows, the user can click on the unsolicited emails that have been filtered out into a separate folder/database/storage area. And, the MPEP 2144.04.III. states that Automating a Manual Activity is obvious. Hence, it is obvious that the manual clicking on the unsolicited email can be automated to automatically occur. One would be motivated to do this to better generate more revenue and also because automating a manual activity is obvious.

Claims 5, 25, 35: Cowden discloses the method of claim 1, further comprising automatically displaying the unsolicited instant advertisement in the primary browser window if the unsolicited instant advertisement meets a user-defined authorization criterion (Figure 7).

Claims 6, 26: Cowden discloses the method of claim 1, further comprising filtering the unsolicited instant advertisement by a user-defined filtering criterion (Figure 7).

Claims 7, 27, 36: Cowden discloses the method of claim 6, further comprising filtering the unsolicited instant advertisement by a plurality of user-defined filtering criteria; and further automatically displaying the unsolicited instant advertisement in the primary browser window if the unsolicited instant advertisement meets at least some of the plurality of user-defined filtering criteria (Figure 7).

Claims 8, 28, 37: Cowden discloses the method of claim 6, further comprising deleting the unsolicited instant advertisement that fails the filtering criterion (Figure 7; [81]).

Claims 9, 29, 38: Cowden discloses the above. Cowden discloses a filtering criterion (Figure 7) and saving bad pop-ups for later viewing ([81] and rejection above). Cowden further discloses presenting ads of interest to the user (Figure 7; [10, 11]). Cowden does not explicitly disclose saving the unsolicited advertisement that meets the filtering criterion. However, Lougmillier discloses filtering, classifying, organizing, and storing both good and bad messages/pop-ups (Abstract, Figure 5) and that Loughmiller's system can work with a variety of content/messages including pop-ups ([14, 126, 129]). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Lougmillier's filtering content and storing both good and bad content can be added to Cowden's filtering content and storing bad content. One would have been motivated to do this in order to allow Cowden's users to view ads of interest at their discretion.

Claims 10, 30, 39: The prior art discloses the method of claim 9, Cowden further discloses notifying a user that the unsolicited instant advertisement has been saved (Figure 8; [81]).

Claims 11: The prior art discloses the method of claim 10, Cowden further discloses notifying the user comprises presenting a visual indicator in the primary web browser (Figure 8).

Claim 12: The prior art discloses the above. Cowden does not explicitly disclose notifying the user comprises presenting an audible indicator. However, Cowden discloses notifying the user via an alert (Figure 8) and Cowden discloses that the computer has audio capabilities ([36]). Therefore, it would have been obvious to one

having ordinary skill in the art at the time the invention was made that Cowden can alert the user with audible sounds. One would have been motivated to do this in order to alert the user in a commonly known way of alerting users that is a desirable form for alerting to many users.

Claim 13: The prior art discloses the above. And, Cowden further discloses categorizing windows ([10]) and Loughmiller discloses prioritizing and categorizing windows that have been saved (citations above). Also, please see the rejection of claim 9 above.

Claims 14: The prior art discloses the method of claim 13, Cowden further discloses aggregating unsolicited instant advertisements in the alternate location ([81]).

Claim 15: The prior art discloses the method of claim 14, Cowden further discloses that the unsolicited instant advertisements are stored with corresponding descriptions ([107, 108]).

Claims 16: Cowden discloses the method of claim 1, further comprising recording an attempt to display an unsolicited instant advertisement is recorded in a log (Cowden, [63]; also, [8] in the Applicant's Specification as to "Background of the Invention").

Claim 17: Cowden discloses the method of claim 16, further comprising transmitting the log to the user ([112]).

Claim 18: Cowden discloses the method of claim 1, further comprising saving the unsolicited instant advertisement in an original form with corresponding text, graphics, and hypertext links ([81]).

Claims 19: Cowden discloses the method of claim 1, further comprising saving the unsolicited instant advertisement in a digest form without graphics ([81]).

Claims 20, 40: Cowden discloses the method of claim 1, wherein the unsolicited instant advertisement comprises any of a pop-up advertisement or a pop-under advertisement ([6]).

Claims 41, 44, 47. Loughmiller further discloses the method of claim 1, further including grouping the unsolicited instant advertisements in the database ([14, 129]).

Claims 42, 45, 48. Jeannin further discloses the method of claim 1, wherein the characterizing is based on at least one of products, content, and category of the unsolicited instant advertisements ([38]).

Claims 43, 46. Jeannin further discloses the method of claim 1, further including allowing an unsolicited instant advertisement of a user-specified topic to be displayed (claims 8, 16; [15, 44, 38]).

Claim 49. The prior art further renders obvious: determining information about a company presenting the unsolicited instant advertisement from databases, reports, privacy policies, and cookie use; and appending the display of the unsolicited instant advertisement in the database with the information about the company presenting the unsolicited instant advertisement (Loughmiller, Fig. 5, [26, 51, 54]; Jeannin, Fig. 7).

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection. Please note the addition of Messer above. Also, please note the following.

On 6/18/10, Applicant added the following new claim amendments to the independent claims:

“scanning the content of the unsolicited instant advertisement for hyperlinks; and automatically activating at least one of the hyperlinks to reward a web site issuing the unsolicited instant advertisement.”

However, the prior art combination with Messer renders obvious these features.

Applicant Spec at these paragraphs was found relevant to these features (from PG_Pub [8, 19, 45, 46]). Also, Applicant states that it is obvious old and well known that (from Applicant's Background of Invention):

“[0008] The web site host tracks the response to unsolicited instant ads on particular web sites. When a user clicks on an unsolicited instant ad, a unique set of information is sent to the web host's server indicating that an advertisement posted through a specific web site garnered a response. The web site responsible for that ad then receives a credit, for example. These credits may translate to money or to other benefits. Conversely, if no visitors to a web site respond to the advertisements or the unsolicited instant ads are “killed” (i.e., closed) by instant ad managers, no revenue is generated by the web site for the web site host. The web site host may then choose to close the web site because it generates no revenue for the web site host.”

Hence, it is obvious, old and well known that sites receive revenue from ads being clicked on.

Cowden further states that websites or web server operators receive revenue from ad activations, “[0005] A typical commercially-operated web server on the Internet

includes some form of advertising. The advertising may be for goods or services. The advertising may also be non-product related (e.g., "vote for John Doe"). Regardless of their message, these advertisements provide revenue to the web server operator."

Jeannin further discloses advertisers collect revenue from advertisements ([41]).

Cowden further discloses the use of Scripts for automatic web page code activation ([82]). Hence, it is obvious that Cowden can automatically click on the links for ads or the links for unsolicited ads in order to generate revenue for a website or web server operator. As a further example of this, Messer 20040230491 discloses tracking revenue from ads ([29, 47]). And Messer discloses automatically clicking on ads to increase revenue for a website or web server operator ("[6]... exemplary fraud of concern includes use of a process that employs a Javascript to artificially multiply the number of clicks, impressions and/or sales on a banner or similar promotional piece. . . [37]... A positive detection branches logic to the next Test, 240 for detecting the existence of the Javascript in association with the promotion vehicle, e.g. a banner ad..."; also [6, 14, 37, 38]). Hence, it is obvious that Cowden can automatically click on the links for ads or the links for unsolicited ads in order to generate revenue for a website or web server operator. One would be motivated to do this to better generate ad revenue. Alternatively, it would have been obvious to one having ordinary skill in the art at the time of the invention to combine the features of the two inventions since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and

one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Alternatively, as the prior art combination shows, the user can click on the unsolicited emails that have been filtered out into a separate folder/database/storage area. And, the MPEP 2144.04.III. states that Automating a Manual Activity is obvious. Hence, it is obvious that the manual clicking on the unsolicited email can be automated to automatically occur. One would be motivated to do this to better generate more revenue and also because automating a manual activity is obvious.

Also, new dependent claim 49 is rejected above.

Conclusion

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

aa) Lamkin 20060161635 at [276]; Plotnick 20050097599 at [150]; Lee 20040064833 at [9]; Brown 20020141544 at [25]; Jeannin 20020083469 at [44]; Broerman 7047313 at det[25] all disclose filtering ads based on metadata of ads;

a) Lapidous and Pennell disclose relevant features.

Aaa) Soulanille 20040039733 discloses click fraud

Aaaa) the following disclose relevant features to automatically clicking on links Muthugopalakrishnan 20080177603 [0004] Examples of click fraud are in a pay per click online advertising system when a person, automated script, or computer program imitates a legitimate user of a web browser clicking on an ad for the purpose of generating a charge per click without having actual interest in the target of the ad's link.

De la Fuente 20020056745 [0017] With the purposed technology, by the mere presence of a promoted product a corresponding Internet web site may be accessed, or banners may be automatically clicked and programmed functions may be executed related to rewarding programs and the like. Once this kind of technology forms part of individual's computer equipment it will be possible to participate in products promoting campaigns and rewarding systems without sending coupons, packaging, etc. Moreover, regional or international marketing programs and campaigns will also be possible.

[0029] The present invention makes possible that a PC (or set top box, or decoder, or Web TV) including a radio frequency reading board allows the interaction of objects or products to be promoted through Internet. Once they are detected, an automatic accessing to web sites and web pages, clicking advertising banners, interlinking web sites, taking part in raffles, etc., is allowed, through communication of IP (Internet Protocol) identifications and other commands. Using the purposed technology, participation of users at home is allowed, assuring that the promoted product is present.

[0049] e.--Merchandising and advertising products: this is an innovative concept due to the incorporation of a micro controller and an antenna during the product's manufacture simulated in its composition. Said micro controller device will be activated representing a determined identification. With the sole presence of the product, users will enable different mechanisms, integrated circuits, etc., or they will auto execute some e-mails, web sites, web banners, etc., or

awarding programs installed therein. Thus, the use of this kind of elements will be promoted (for example, pins, watches, mouse pads, buckles, etc.).

7318049 ianacci (185) such functions will produce, identify, compare, determine, and select available and preferred benefit incentives and awards and then automatically determine appropriate actions and payment and redemption accounts for use to acquire and utilise said incentives and awards.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571)272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Art Unit: 3622

Arthur Duran
Primary Examiner
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7/7/10